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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/403,803	03/17/1995	RON S. ISRAELI	41426-A-PCT-	4181

7590 05/23/2005
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EXAMINER

GUCKER, STEPHEN

ART UNIT PAPER NUMBER

1647

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/403,803

Applicant(s)

ISRAELI ET AL.

Examiner

Stephen Gucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 116-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 116-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/29/04, 4/1/05, 8/16/04, 11/18/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
3. The finality of the last Office Action is withdrawn in order that a new grounds of rejection may be made. Because prosecution is being re-opened, the Appeal Brief filed 1/21/05 is dismissed.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 116-119 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of US 5,538,866 in view

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of Lerner. The patented claims teach isolated nucleic acids, vectors, host cells, and methods for producing prostate specific membrane antigen (PSMA). The patented claims do not teach 15-mer or longer nucleic acid fragments of PSMA. Lerner teaches the usefulness of using smaller regions of nucleic acids or genes to produce antibodies specific for select regions of the encoded protein's structure (pages 11, 14-17, and 23), and then the antibodies can be used as highly selective and specific probes for the encoded protein in question. It would have been obvious at the time of the invention for one of ordinary skill in the art to make and use the small PSMA nucleic acid fragments of the present invention from the larger patented nucleic acids in order to make highly specific antibody probes for particular regions of the PSMA as taught by Lerner. As Lerner teaches, the practitioners of the antibody arts would be highly motivated to use small nucleic acids to make small peptides for certain small regions of the PSMA protein in order to make antibodies selective and specific for those regions so that the structure and functioning of the PSMA could be studied and distinguished from any PSMA alternate splice variants, soluble fragments, mutations, etc. as discussed for many proteins in general by Lerner, rendering the instant claims *prima facie* obvious.

6. Claims 116-119 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of US 5,935,818 in view of Lerner. The patented claims teach isolated nucleic acids, vectors, host cells, and methods for producing alternately spliced prostate specific membrane antigen (PSMA'). The patented claims do not teach 15-mer or longer nucleic acid fragments of PSMA'. Lerner teaches the usefulness of using smaller regions of nucleic acids or genes to

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produce antibodies specific for select regions of the encoded protein's structure (pages 11, 14-17, and 23), and then the antibodies can be used as highly selective and specific probes for the encoded protein in question. It would have been obvious at the time of the invention for one of ordinary skill in the art to make and use the small PSMA' nucleic acid fragments of the present invention from the larger patented nucleic acids in order to make highly specific antibody probes for particular regions of the PSMA' as taught by Lerner. As Lerner teaches, the practitioners of the antibody arts would be highly motivated to use small nucleic acids to make small peptides for certain small regions of the PSMA' protein in order to make antibodies selective and specific for those regions so that the structure and functioning of the PSMA' could be studied and distinguished from any PSMA' alternate splice variants, soluble fragments, mutations, etc. as discussed for many proteins in general by Lerner, rendering the instant claims *prima facie* obvious.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887. The fax phone number for this Group is currently (571)-273-8300.



Stephen Gucker

May 16, 2005



BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600